

REMARKS

New Claims 95-142 are presented by this amendment and prior Claims 35, 39, 40, 42-44, 47, 83 and 84 are amended to depend from new independent Claim 95. The other claims have been canceled by either this amendment or a prior amendment.

Support in the original Specification for new independent Claims 95, 105, 107, 125, 133 and 138 and the new dependent claims is set forth at page 1, lines 5-9 (paragraph 1), page 2, lines 18-20 (paragraph 15), page 5, lines 20-23 (paragraph 45), page 6, lines 17-23 (paragraph 47), page 8, line 1 to page 9, line 9 (paragraphs 50 and 51), page 11, line 10 to page 12, line 1 (paragraph 56), page 17, lines 1-23 (paragraphs 89-91) and page 35, line 1 to page 36, line 11 (paragraphs 152-155).

The Title and the Background and Summary of the Invention portions of the specification are amended to be consistent with new independent Claims 95, 105 and 107.

Claim Rejections 35 USC § 103

New independent claims 95, 105, 125 and 133 require the feature of:

- providing economic gain to a contributor of a problem or need to be solved by an invention to a database of accumulated ideas for prospectively patentable inventions, wherein said economic gain is stock, bonds, cash or rights to a portion of income from property rights to inventions derived at least in part from said accumulated ideas, as required by step (e), in combination with the feature of
- utilizing a computer system to effect a transfer by the contributor of the problem or need of his property rights to inventions derived at least in part from his contribution of a problem or need, as required by step (c).

New independent claims 107 and 138 require the feature of:

- providing economic gain to a contributor of a problem or need to be solved by an invention to a database of accumulated ideas for prospectively patentable inventions, wherein said economic gain is stock, bonds, cash or rights to a portion of income from property rights to inventions derived at least in part from said accumulated ideas, as required by step (d), in combination with the feature of
- utilizing a computer system to obligate the contributor of the problem or need to transfer his property rights to inventions derived at least in part from his contribution of a problem or need as a prerequisite to contributing the problem or need to the database, as required by step (c).

To the extent that the rejection of Claims 2, 3, 32, 35, 39-48, 67, 69 and 77-94 as being unpatentable over *Uchio* in view of *Kossovsky* is applicable to the pending claims, such rejection is respectfully traversed. Applicants do not agree with the Examiner's assertions that various specific elements of such claims are disclosed by *Uchio* or *Kossovsky*.

The Examiner is directed to *Powell*, U.S. Patent Application Publication No. US 2001/0032189, *Waters*, U.S. Patent Application Publication No. US 2002/0032659 and *Smith, III et al.*, U.S. Patent Application Publication No. 2003/0036947. *Powell* and *Waters* were cited in previously filed Information Disclosure Statements and *Smith, III* is cited in an Information Disclosure Statement being filed herewith. *Powell, Waters* and *Smith, III* are believed to be relevant to the pending claims.

The pending claims are patentable over *Uchio, Kossovsky, Powell, Waters* and/or *Smith, III* by reason of, *inter alia*, the combination of features respectively recited in new independent Claims 95, 105, 107, 125, 133 and 138.

None of these five references specifically mention or suggest:

- the feature of utilizing a computer system to effect a transfer by a contributor of a problem or need of his property rights to inventions derived at least in part from his contribution of a problem or need, as required by Claims 95, 105, 125 and 133, or
- the feature of utilizing a computer system to obligate a contributor of a problem or need to transfer his property rights to inventions derived at least in part from his contribution of a problem or need as a prerequisite to contributing the problem or need to a database of accumulated ideas for prospectively patentable inventions, as required by Claims 107 and 138.

Neither *Uchio* nor *Kossovsky* specifically mention the contribution of a problem or need to be solved by an invention to a database of accumulated ideas for prospectively patentable inventions.

Uchio describes a method and apparatus for managing documents related to patent applications. *Uchio* does not specifically mention either the contribution of a problem or need to be solved by an invention to a database of accumulated ideas for prospectively patentable inventions or the provision of economic gain to a contributor of a problem or need to such a database.

The method and apparatus described by *Uchio* are for managing documents related to patent applications rather than to managing property rights to inventions that are derived from invention ideas that are accumulated in a computer database.

It is not seen where *Uchio* describes any obligation on the part of the entity that contributes the patent-application-related information to the database to transfer any rights to the inventions described in the patent applications. It is not understood why the Examiner asserts that an obligation to transfer property rights to inventions derived from invention idea in a database is taught in paragraphs 59 and 60 of *Uchio*. Neither of these two paragraphs mentions such a transfer.

It is not seen where *Uchio* describes requiring contributors of ideas to enter into a membership as a prerequisite for contributing ideas to the database. It is not understood why the Examiner asserts that such a prerequisite is taught in paragraph 147 of *Uchio*. Paragraph 147 does not mention such a prerequisite. In any event, *Uchio* does not describe any obligation to transfer rights as being incident to any membership.

Kossovsky does not specifically mention either the contribution of a problem or need to be solved by an invention to a database of accumulated ideas for prospectively patentable inventions or the provision of economic gain to a contributor of a problem or need to such a database.

Kossovsky describes the listing in a database of intellectual property (IP) rights to inventions that are available for sale or license in a computer database. The listings of IP rights are contributed to the database by the owners of the IP rights.

The property rights that are transferred by *Kossovsky's* method and apparatus are not property rights to inventions that are derived from invention ideas in the database listing of IP rights, as required by the claims, inasmuch as the inventions described in the information that is accumulated in the database were derived prior to any listing in the database of inventions related to the listed IP rights.

Conclusion

It is respectfully submitted that it is unobvious to both:

- provide economic gain to a contributor of a problem or need to be solved by an invention to a database of accumulated ideas for prospectively patentable inventions, wherein said economic gain is stock, bonds, cash or rights to a portion of income from property rights to inventions derived at least in part from said accumulated ideas, and either
- utilizing a computer system to effect a transfer of property rights by the contributor of the problem or need to a transferee other than the contributor of the problem or need, wherein the transferred property rights are rights to inventions derived at least in part from the problem or need that he contributed, as required by step (c) of Claims 95, 105, 125 and 133, or
- utilizing a computer system to obligate the contributor of the problem or need to transfer his property rights to inventions derived at least in part from his contribution of a problem or need as a prerequisite to his contributing the problem or need to the database, as required by step (c) of Claims 107 and 138.

Reconsideration and allowance of the claims are respectfully requested.

Contingent Request for Telephone Interview

Should the Examiner not be disposed to allow the pending claims, the undersigned attorney respectfully requests a telephone interview with the Examiner prior to the mailing of a further office action.

Respectfully submitted,

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